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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/815,356	03/31/2004	Mark S. Zeiner	END5008USCIP2	8274

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EXAMINER

YABUT, DIANE D

ART UNIT	PAPER NUMBER
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3734

MAIL DATE	DELIVERY MODE
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06/07/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/815,356

Applicant(s)

ZEINER, MARK S.

Examiner

Diane Yabut

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 March 2007.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6,8-11,17,19 and 23-32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6,8-11,17,19 and 23-32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 August 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is in response to applicant's amendment received on 19 March 2007.

The examiner acknowledges the amendments made to the claims as well as the correction of inventorship.

Inventorship

2. In view of the papers filed 16 March 2007, it has been found that this nonprovisional application, as filed, through error and without deceptive intent, improperly set forth the inventorship, and accordingly, this application has been corrected in compliance with 37 CFR 1.48(a). The inventorship of this application has been changed by the addition of the inventors Paul T. Franer, Michael S. Cropper, Thomas A. Gilker, Geoffrey C. Hueil, David K. Norvell, Brian J. Thompson, and Aaron C. Voegele (in addition to inventor Mark S. Zeiner).

The application will be forwarded to the Office of Initial Patent Examination (OIPE) for issuance of a corrected filing receipt, and correction of Office records to reflect the inventorship as corrected.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1, 3, 6, 8-9, 11, 17, 19, 23-27, and 29-32 are rejected under 35 U.S.C. 102(b) as being anticipated by **Haber** (U.S. Patent No. **5,385,552**).

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Claims 1, 6, 8-9, 17, 23-27, 29-32: Haber discloses a trocar **2** with a hollow cannula **32** having a distal end and proximal end and a valve housing **58** attached to the proximal end of the cannula, wherein the proximal end has a wall attached thereto having an aperture therethrough, and a seal assembly **122** disposed within said housing comprising a first substantially rigid ring **132**, and a second substantially rigid ring **134** and a plurality of layered elastomeric members, or four separate semicircular seal segments **126**, compressed therebetween, having a circumference between 180 to 270 degrees, and arranged circumferentially about an aperture in an alternating over and under pattern in a non-planar shape (the elastomeric members also having a non-planar shape prior to being assembled together), and circumscribing an aperture in an interwoven pattern and cooperate to seal against objects positioned within the aperture, and each seal segment having a starting edge facing in the same circumferential direction and an ending edge facing in the opposite circumferential direction wherein the starting edge of each seal segment overlaps and is positioned on top of the ending edge of the adjacent seal segment and the seal segments cooperate to seal against objects positioned within the aperture (Figures 2 and 5A).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 2-3, 10-11, 19 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Haber** (U.S. Patent No. **5,385,552**), as applied to Claims 1, 9-10, 17 and 25 above, and further in view of **Honkanen** (U.S. Patent No. **4,655,752**).

Claims 2 and 10: Haber discloses the claimed device except for the plurality of layered elastomeric members forming a conical shape.

Honkanen teaches a cannula with a conically-shaped seal **55** (Figure 4). Honkanen teaches that the conical shape assists in the formation of a tight seal about an instrument being inserted into the cannula since fluid pressure will cause the conical seal member to collapse into the instrument and cause it to adhere more securely thereto (col. 4, lines 53-58). It would have been obvious to one of ordinary skill in the art at the time of invention to provide conically-shaped elastomeric members, as taught by Honkanen, to Haber in order to facilitate a secure adhesion to the inserted instrument.

Claims 3, 11, and 19: Haber discloses the claimed device except for the elastomeric members comprising a proximal flange portion and an inwardly extending portion extending distally therefrom, wherein said proximal flange portions are disposed between and are abutting against said rings.

Honkanen teaches a proximal flange portion **56** and an inwardly extending portion **58**, wherein said proximal flange portions which would be disposed between and are abutting against the rings in the device of Haber (Figure 2). It would have been obvious to one of ordinary skill in the art at the time of invention to provide a proximal

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flange portion and an inwardly extending portion, as taught by Honkanen, to Haber since it was known in the art that seals with such portions are more securely mounted to the valve housing and more efficiently seal instruments that move through the valve.

Claim 28: Haber discloses the claimed device except for the seal further providing zero-closure.

Honkanen teaches the seal further providing zero-closure (Figure 5) and it would have been obvious to one of ordinary skill in the art to modify Haber by providing zero-closure, as taught by Honkanen, in order to form a tighter seal that would allow a snug fit about the instrument and to prevent fluid from escaping out the top end of the cannula (col. 4, lines 45-52).

5. Claims 4-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Haber** (U.S. Patent No. **5,385,552**) in view of **Hart** (U.S. Patent No. **5,385,553**)

Claim 4: Haber discloses the claimed device except for the seal assembly having an outer perimeter which is attached to a flotation means.

Hart teaches the seal assembly having an outer perimeter which is attached to a flotation means **39** that allows for movement of the septum orifice to an off-axis position without deformation (Figure 12, col. 2, lines 6-18 and col. 10, lines 41-63). It would have been obvious to one of ordinary skill in the art at the time of invention to modify Haber in providing a flotation means being attached to the outer perimeter of the seal assembly, as taught by Hart, in order to prevent deformation of the septum orifice.

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Claim 5: Haber discloses the claimed device except for the seal assembly including a plurality of protectors disposed proximal to said elastomeric seal.

Hart teaches seal assembly including a plurality of protectors that comprises outer leaves **105, 107** and inner leaves **125, 127** disposed proximal to said elastomeric seal (Figures 9-10, col. 6, lines 48-68). It would have been obvious to one of ordinary skill in the art at the time of invention to provide a plurality of protectors proximal to elastomeric seal, as taught by Hart, to Haber in order to shield the sealing members from the pushing force of the instruments.

Response to Arguments

6. Applicant's arguments with respect to claims 1, 3, 6, 8-9, 17, 19, 23-27, and 29-32 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Diane Yabut whose telephone number is (571) 272-6831. The examiner can normally be reached on M-F: 9AM-4PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Hayes can be reached on (571) 272-4959. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

DY

A handwritten signature in black ink, appearing to read "M J Hayes", with a long horizontal flourish extending to the right.

MICHAEL J. HAYES
SUPERVISORY PATENT EXAMINER